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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,833	06/21/2001	Robert Seseck	10006174-1	7851

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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/887,833	SESEK, ROBERT	
	Examiner	Art Unit	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15,18,19 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15,18,19 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the application amendment filed on 9/20/2004.
2. Applicant has amended claims 1, 2, 4, 6, 7, 11, 12, 15, 18, 19, 24 and 25.
3. Applicant has cancelled claims 8, 16, 17 and 20-22.
4. Claims 1-7, 9-15, 18, 19 and 23-25 are pending in the case. Claims 1, 7, 12, 15, 19 and 23 are independent claims.
5. Applicant has amended the specification in response to the objections cited by the examiner in the *Specification* section of the previous office action (dated 6/16/2004). Applicant's amendment has addressed the objections previously made, and therefore, in view of this amendment, the objections to the specification are withdrawn.
6. Applicant has amended claims 4, 24 and 25 in response to the rejections cited by the examiner in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 6/16/2004). Applicant's amendment has addressed the 35 USC 112 rejections previously made, and therefore, in view of this amendment, the 35 USC 112 rejections to claims 4, 24 and 25 are withdrawn.

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7. Rejections of claims 1-7, 9, 10, 15, 18, 23 and 25 made under 35 USC 102 as being anticipated by Murphy (US Publication 2002/0033961) are withdrawn as necessitated by amendment.
8. Rejection of claim 11 made under 35 USC 103 as being obvious over Murphy (US Publication 2002/0033961) in view of Siitonen (US Patent 6,049,796) is withdrawn as necessitated by amendment.
9. Rejections of claims 8, 16, 17 and 20-22 made under 35 USC 112, 35 USC 102 or 35 USC 103 in the previous office action (dated 6/16/2004) are moot in view of applicant's cancellation of these claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 902 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

11. Claims 1-7, 9, 10, 15, 18, 23 and 25 are rejected and claims 12, 13, 19 and 24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy, US Publication 2002/0033961, filed 6/11/2001, published 3/21/2002.

12. **Regarding independent claim 1**, Murphy discloses sending a document from a sender to a receiver via an electronic address. Murphy recites: *"it is a still further object of the present invention to provide a device that can be easily connected to standard class 1, 2, and 3 fax machines, optical scanners and screen capture methods to convert the image data stream to TCP and UDP enabled format for direct IP address transmission/reception with similarly equipped fax machines, printers, image rendering machines and capable computer terminals over the Internet"* (page 3, paragraph 29). Murphy further discloses obtaining an electronic address in Figure 3, at reference sign 32 (shown as an "Address Book") located externally from the document sender (shown as "Facsimile Machine" at reference sign 14).

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Murphy discloses the use of wireless communications. Murphy recites: "*cellular telephone communication devices*" (page 7, paragraph 106).

Murphy fails to explicitly describe importing the addresses using a wireless communication technique. However, Murphy indicates the use of wireless communications. Murphy recites: "*It is a still further object of the present invention to provide a method and apparatus for implementing the present invention over land line as well as wireless network architectures*" (page 3, paragraph 38).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to use wireless transfer of address information to provide "*an economical device that can be easily connected to present class 1, 2, and 3 fax machines, optical scanners and screen capture methods and that will enable them to communicate over internet global area packet switched networks*" (Murphy, page 2, paragraph 25).

13. **Regarding dependent claims 2 and 4**, Murphy discloses the use of an address book disposed in an external device as described above. Murphy further discloses the external device as a mobile phone. Murphy recites "*cellular telephone communication devices*" (page 7, paragraph 106).
14. **Regarding dependent claim 3**, Murphy discloses a digital document-sending device in Figure 2 at reference sign 14 (described as a "*fax machine*" on page 4, paragraph 56).

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15. **Regarding dependent claim 5**, Murphy discloses the document receiver as facsimile machine. Murphy recites: "*The remote facsimile machine contains a receiver section 590*" (page 1, paragraph 11).
16. **Regarding dependent claim 6**, Murphy discloses an address in the form of a network address. Murphy recites: "*It is a still further object of the present invention to provide a device that can be easily connected to standard class 1, 2, and 3 fax machines, optical scanners and screen capture methods to convert the image data stream to TCP and UDP enabled format for direct IP address transmission/reception with similarly equipped fax machines, printers, image rendering machines and capable computer terminals over the Internet*" (page 3, paragraph 29). Murphy further discloses in Figure 3, an address book (at reference sign 32) located externally from the document sender (shown as "*Facsimile Machine*" at reference sign 14).
17. **Regarding independent claim 7**, the claim contains substantially the same subject matter as claim 1, and is rejected using the same rationale.
18. **Regarding dependent claim 9**, Murphy discloses imaging a paper document. Murphy recites: "*In state of the art facsimile machines, the transmitter section 500 (see FIG. 10) typically includes a scanner device 509 which scans the page to be transmitted*" (page 1, paragraph 9).

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19. **Regarding dependent claim 10**, Murphy discloses storing the address in an address book in Figure 4, at reference sign 54, shown as "*Buffer Address Storage*".
20. **Regarding independent claim 12**, Murphy discloses imaging a paper document. Murphy recites: "*in state of the art facsimile machines, the transmitter section 500 (see FIG. 10) typically includes a scanner device 501 which scans the page to be transmitted*" (page 1, paragraph 9). Murphy discloses a user interface in Figure 10 at reference sign 94. Other limitations of the claim are directed toward a device for the method of claims 1 and 3 combined, and are rejected using the same rationale.
21. **Regarding dependent claim 13**, Murphy discloses a digital document-sending device in Figure 2 at reference sign 14 (described as a "*fax machine*" on page 4, paragraph 56). Murphy discloses a user interface in Figure 10 at reference sign 94.
22. **Regarding independent claim 15**, the claim is directed toward a system for the method of claims 1 and 2 combined, and is rejected using the same rationale.
23. **Regarding dependent claim 18**, Murphy discloses in Figure 3, an address book of electronic document receivers (reference sign 32), and an external retrieval mechanism (at reference sign 16).

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24. **Regarding independent claim 19**, the claim is directed toward a device for the method of claims 4, 6 and 8 combined, and is rejected using the same rationale.
25. **Regarding claims 23 and 25**, the claims are directed toward a computer readable medium for the method of claims 7 and 9 respectively, and are rejected using the same rationale.
26. **Regarding dependent claim 24**, the claim is directed toward a computer readable medium for the method of claim 1, and is rejected using the same rationale.
27. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of Hattori et al. US Patent 6,512,599, filed 1/19/1999, patented 1/28/2003.
28. **Regarding dependent claim 11**, Murphy discloses sending documents with addresses imported from mobile computing devices as described above. Murphy fails to disclose erasing transmission data after transmission of the document. Hattori teaches erasing transmission data after transmission of the document. Hattori recites: *"During the fax to print and send function, the fax transmission data is deleted after the fax transmission data is printed and transmitted"* (column 40, lines 9-11)

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine Murphy's document sending method with

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the transmission data eraser process of Hattori because: *"the fax transmission data is deleted after it has been transmitted, the memory region of the RAM 63 or 64, which stores the fax transmission data, can be effectively used"* (Hattori, column 40, lines 12-15)

29. Claim 14 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of Besprosvan. US Publication 2002/0124057, filed 3/5/2001, published 9/5/2002.

30. **Regarding dependent claim 14**, Murphy discloses a document-sending device with addresses imported from mobile computing devices as described above. Murphy fails to disclose the use of a distribution list. Besprosvan teaches the use of a distribution list. Besprosvan recites: "The sixth operational feature relating to Web browser access respecting the address book is "group lists." The user is able to create group distribution lists. Group lists allow for message distribution to selected fax and/or e-mail entries in the group" (page 6, paragraph 84).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine Murphy's document sending with the distribution list as taught by Besprosvan, in order to provide "a unified communications system to integrate telephone, facsimile, and e-mail communications, as well as communications through document dissemination and video or other digital communication technique" (Besprosvan, page 1, paragraph 1).

Response to Arguments

31. Applicant's arguments with respect to claims 1-7, 9, 10, 11, 15, 18, 21-23 and 25 have been considered but are moot in view of the new ground(s) of rejection as described above.
32. Applicant's arguments filed 9/20/2004 with respect to claims 12, 13, 14, 19 and 24 have been fully considered but they are not persuasive.
33. **Regarding independent claim 12**, the applicant states: "*user interface 94 of Murphy (cited in the Office Action) is not configured to request an electronic address of an electronic document receiver from a mobile computing device*" (page 13, first paragraph). The applicant is directed to the rejection of claim 12 as restated above. In further support of this rejection Murphy offers the following description of his user interface. Murphy recites: "*The user inputs or retrieves the IP e-mail address, that is associated with the intended recipients phone number of the selected remote fax machine via the keypad 52 or remotely from the flash eeprom or remote data base. The LCD 94 displays, via the USART 90 this information*" (page 5, paragraph 71).
34. **Regarding dependent claims 13 and 14**, the applicant states: "*Based upon their dependency from independent claim 12, claims 13-14 are believed to be allowable as well*" (page 13, third paragraph). Applicant is directed to the rejection of claims 13 and 14 as restated above and to the rejection of claim 12 as restated above.

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35. **Regarding independent claim 19**, the applicant states: "*Murphy fails to disclose any such mobile computing device separate form an electronic document sender configured to perform the specified functions*" (page 13, fifth paragraph). Applicant is directed to the rejection of claim 19 as restated above.

Conclusion

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

37. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,576,846	11-1996	Tsukamoto et al.
• US-5,583,655	12-1996	Tsukamoto et al.
• US-5,710,843	01-1998	Tsukamoto et al.
• US-5,877,746	03-1999	Parks et al.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone

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number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
November 24, 2004


STEPHEN S. HONG
PRIMARY EXAMINER